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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,519	04/12/2001	Harry C. Merritt		2520

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EXAMINER

ROWAN, KURT C

ART UNIT

PAPER NUMBER

3643

DATE MAILED: 04/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/833,519

Applicant(s)
MERRITT

Examiner
KURT ROWAN

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3643



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 26, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

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Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Feb 26, 2003 has been entered.

Claim Rejections - 35 U.S.C. § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is confusing since "...said mounting section portion of said elongated piece said elongate piece..." appears to be missing either a "," or some language. Also, in line 1, it appears that a "," should be inserted after "1".

Claim Rejections - 35 U.S.C. § 102

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 12, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Haber.

The patent to Haber shows a fishing rod having a throwing projectile 36 with a bore 44, 45 therethrough as shown in Figs. 1-5. Haber shows an elongated piece 17 having a first mounting section 27 for mounting the elongated piece on the terminal end of a fishing rod 15. Haber shows a second throwing projectile section 28 whereby the throwing projectile slides onto the throwing projectile section by the throwing projectile bore. Haber shows means for mounting the elongated piece using the first mounting section to the terminal end of a fishing rod. The rod of Haber can be considered as a fly rod since no structure is recited to differentiate a fly rod from a spinning rod and the rod of Haber will function as a fly rod with equipped with a fly reel and line. Haber shows mounting the elongate piece on the terminal end of the rod without removing or modifying any hardware on the rod. Applicant has not stated what this hardware is. Further, the rod of Haber can be used as a device to teach casting a fly line without actual use of a fly line since Haber shows all of the structural elements recited.

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Claim Rejections - 35 U.S.C. § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-11, 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haber.

The patent to Haber shows a fishing rod and rig as discussed above. Haber does not show a method for teaching the proper motion for casting a fly line. However, Haber makes a casting motion and throws the projectile 36 from the throwing projectile section. In reference to claims 4, 19, Haber shows an angle of 90 degrees, but it would have been obvious to employ other angles since the function is the same. In reference to claim 5, inherently the throwing projectile of Haber most closely approximates a particular type of line. In reference to claims 6, 10, Haber shows means for stopping 29. In reference to claims 7, 14, Haber does not show a spherical throwing projectile, but it would have been obvious to employ a spherical throwing projectile since the function is the same and no stated problem is solved by the shape of the throwing projectile. In reference to claims 8, 9, 15 and 16, 20 the size would be determined through routine experimentation since no showing of unexpected results was made. Hence, it would have been obvious to employ a spherical throwing projectile of a diameter of between 1 and 3 inches which approximates 30 feet of fly line. In reference to claim 11, Haber shows

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means 37 for holding the projectile in place against the means for stopping 29. In reference to claim 17, it would have been obvious to observe the results of the cast by Haber and if the cast did not end up in the right place to repeat the cast to obtain a proper trajectory to land the bait in the desired location for the purpose of catching fish. Also, see the rejection of claims 1 and 12, above. In reference to claim 18, see the rejection of claim 3, above.

Claim 17 should be amended to include that the elongated piece is mounted in the tip eyelet as shown in Fig. 2 and a whereby clause should state that no fishing line is used when the practice casting is being done or that the eyelets are free of fly line in equivalent language.

Response to Arguments

8. Applicant's arguments filed Feb. 26, 2003 have been fully considered but they are not persuasive. Applicant argues that Haber has retainer elements 44, 45 are not a bore in the throwing projectile. This is correct. The bore in the throwing projectile is not labeled. However, retainer elements mount in that bore and a bore passes through the retainer elements which holds the loop section 40 of the line. A bore is required in the throwing projectile for casting device to work. The retainer elements slide in the bore or apertured portion 23 of throwing projectile section 28. See Fig. 3. The brace or first mounting section 27 of Haber is connected to elongate piece 17 as shown in Fig. 1. Applicant argues the examiner's conclusion that the tip 17 has an integral part of it a first mounting section 27. Claims 1, 12, and 17 do not mention integral. Clearly the brace 27 is part of the overall tip 17 since the brace is used to mount the tip to the

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fishing rod. The apertured magnet tip member 17 of Haber is an elongated piece since it has a length. Also, the length is longer than throwing piece 36. Further, the member 17 can be considered to elongated in diameter since the diameter is greater than that of the rod, and the line. Clearly, an object with a dimension larger than another dimension is elongated. Haber shows a terminal eyelet and it does not appear that the rod of Haber has been modified since the eyelet shown functions as a terminal eyelet. Hence, it appears that the rod is built this way to begin with and not modified. Claim 2 recites that the mounting section portion 27 of the elongate piece is bent at a predetermined angle. The mounting section 27 of Haber is clearly bent at an angle of 90 degrees as shown in Figs. 1-3, 5. As to the disc being thrown to travel initially in a direction parallel to the fishing rod, which shows the disc, line section 40 and weight 24 far from being parallel to the fishing rod. Whether or not the rod is for training purposes only is not material to determine patentability. As stated above, Haber shows structure to perform the intended use.

In response to applicant's argument that the fishing rod is to be used without fly line, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the elongate tube is bent at a predetermined angle of 90 degrees) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to the statement that the disk 36 of Haber not slide into the magnetized portion by means of a bore, see Fig. 3 of Haber which shows the disk 36 inside the magnetized piece 28 by way of aperture 23a and the element 44 also slides into aperture 23a. The claims do not require that bore is the only way the throwing projectile the throwing projectile is mounted on the fishing rod. Clearly the disk of Haber is thrown is it travels with the fishing line. The claims do not require that the disk is thrown by itself. Haber shows an elongate tube, a bore for mounting a throwing projectile on the elongate tube and requires no modification of the rod.

The claims should recite that the tube 12 is mounted through the tip line guide of a fishing rod as shown in Fig.2 with section 13 parallel to the fishing rod and another section 14 having the throwing projectile 50 at angle greater than 90 degrees with respect to the section 13 in conjunction with other limitations found in claim 1.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **KURT ROWAN** whose telephone number is (703) 308-2321.

The examiner can normally be reached on Monday-Thursday from 6:30 a.m. to 5:00 p.m.

The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4195 or (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to read "Kurt Rowan", with a stylized flourish at the end.

KURT ROWAN

PRIMARY EXAMINER

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April 24, 2003